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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,632	05/23/2001	Kerry McLellan	KNK-3.2.001/3705	1720
1059	7590	04/26/2004	EXAMINER	
BERESKIN AND PARR SCOTIA PLAZA 40 KING STREET WEST-SUITE 4000 BOX 401 TORONTO, ON M5H 3Y2 CANADA			WEBB, JAMISUE A	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 04/26/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/864,632

Applicant(s)

MCLELLAN, KERRY

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2,6,7,8</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 70 and 90. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claim 33 is objected to because of the following informalities: This claim uses the phrase “key” and “another key”, which can create confusion when using “said key”, the examiner suggest using first and second to distinguish between the two keys. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, and 20-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. With respect to Claim 3: the phrase “comprising a network coupled to” is indefinite. This claim is an apparatus claim, which is a structural claim. A network refers to a system of

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communication, and does not constitute any structural limitation. Therefore it is unclear how an apparatus can comprise a network. The examiner suggest using a "network interface" or using a phrase on how the remote location and lock is in data communication, for example what hardware is used, is it a telephone line, a cable connected to the internet, or a IR transmitter/receive. Make sure no new matter is added when amending the claim.

6. Claim 20 recites the limitation "the delivery" in line 2. There is insufficient antecedent basis for this limitation in the claim.

7. Claims 26 and 27 recite the limitation "said identification" in line 2. There is insufficient antecedent basis for this limitation in the claim. Is this the parcel identification or the locker identification?

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-3, 5-17, 19, 33, 35 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Shannon (US 2001/0045449).

10. With respect to Claims 1 and 35: Shannon discloses the use of an apparatus for storing a parcel comprising:

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- a. A storage locker (Figures 1, 3-6),
  - b. A lock coupled to locker (50)
  - c. A key for accessing storage locker (130)
  - d. The key configured to change after use (page 2, paragraph 0012)
11. With respect to Claims 2 and 35: Shannon discloses the key being synchronized with a key at a location remote from said lock (synchronized between delivery person and receiver, page 5, paragraph 0038).
12. With respect to Claim 3: Shannon discloses a control unit located at remote location, external to device (page 4, paragraph 0036).
13. With respect to Claims 5-9: See Page 4, paragraphs 0034 and 0037.
14. With respect to Claim 10: See Page 3, paragraph 0027.
15. With respect to Claims 11-15: Shannon discloses the locker comprising a plurality of openings or compartments, and different size shelves, all accessed by the same overall door and code (page 3, paragraph 0027).
16. With respect to Claim 16: Shannon discloses a method of delivering a parcel comprising the steps of placing parcel in locker, locking storage locker, where locker is accessed by key, and changing key after being used (page 5, paragraphs 0039, 0041 and 0042).
17. With respect to Claims 17 and 33: See Page 5, paragraph 0038.
18. With respect to Claim 19: See Page 5, paragraph 0036.
19. Claims XXXXXXXX are rejected under 35 U.S.C. 102(e) as being anticipated by Ogilvie et al. (6,344,796).

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20. With respect to Claim 16: Ogilvie discloses the use of a method of delivering a parcel comprising the steps of:

- a. Placing parcel in locker (column 4, lines 1-4),
- b. Locking locker (column 4, lines 4-5),
- c. Wherein storage locker is accessible with a key (column 4, lines 12-20), and
- d. Changing said key subsequent to use (column 4 lines 20-23).

21. With respect to Claim 17: See Claim 1.

22. With respect to Claim 19: See Column 4, lines 45-53 and Claims 11 and 12.

23. With respect to Claim 20-25 and 30-33: See column 4, lines 24-53.

24. With respect to Claim 26: See Claim 15.

25. With respect to Claims 28 and 29: See Column 4, lines 54-67 and column 5, lines 22-30.

26. With respect to Claims 34 and 37: Ogilvie discloses a method and means for delivering a parcel comprising the steps:

- a. Providing parcel and depot selection to delivery agent (carrier or shipper) (column 3, lines 50-52),
- b. Delivering parcel to depot (column 3, lines 59-65),
- c. Delivery agent selecting locker and placing parcel in locker (column 4, lines 1-5),
- d. Providing parcel ID and locker ID to central system (column 4, lines 6-23),
- e. Central system providing customer with parcel ID and locker ID (column 4, lines 24-44),
- f. Customer using key to retrieve parcel from locker (column 4, lines 45-67).

***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie.

29. Ogilvie as disclosed for Claim 24 above, discloses using e-mail to send a message to the customer that the delivery is ready for pick-up (column 2, lines 50-67), but fails to disclose verifying that the customer received the e-mail. It is old and well known in the art that when an e-mail is received there is an option of a receipt. Therefore it is obvious to one having ordinary skill in the art that to add a read receipt onto the e-mail that is sent to customer, to make sure the customer received the message.

30. Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shannon in view of O'Connor (6,330,816).

31. Shannon, as disclosed above for Claims 1 and 16, discloses the use of a storage locker with either a mechanical or an electrical lock (Page 4, paragraph 0037), but fails to disclose the use of an electrical key, which accesses a mechanical key to open the lock box. O'Connor discloses a lock, that is mounted on a door in a closed position (see abstract), that contains a mechanical key that opens the door and is accessed using a keypad, or an electronic key (see figures 7-9 with corresponding detailed descriptions). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the storage locker of Shannon,

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to include the lock box with access to the mechanical key, as disclosed by O'Connor, in order to provide the benefit of enabling limited access to an unattended area which is a mechanical lock (See O'Connor column 1).

### *Conclusion*

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

33. US References:

- a. Danier et al. (5,280,518) discloses the use of an electronic lock box,
- b. Mardon discloses a storage system with electronic locks for access,
- c. Van Till et al. (6,404,337) discloses the use of an unattended storage system,
- d. Sansone et al. (6,028,517) discloses the use of an indication system for deposit and withdrawal of items from a receptacle,
- e. Tsukuda (6,085,170) discloses the use of a delivery management system for delivery packages to agents or unattended lock boxes,
- f. Stephens et al. (6,323,782) discloses the use of an unattended delivery system.

34. Foreign references:

- g. McGinn (WO 02/095536 A2) discloses the use of a system and method for unattended delivery of goods.

35. NPL:

- h. IBM Technical Disclosure (NNRD439131) discloses the use of an automated parcel and delivery machine.

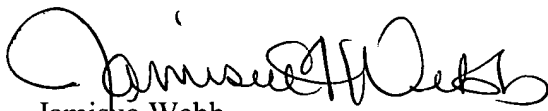


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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